

REMARKS/ARGUMENTS

Reconsideration of this patent application is respectfully requested in view of the foregoing amendments and the following remarks.

Claims 1-20, 24, 30 and 32 have been canceled. Claims 21-23, 25-29 31, and 33-37 remain in the application. Claims 21, 22, 35-37 have been amended.

The Examiner has rejected claims 21-23, 25, 26, 28, 31, and 33-37 under 35 U.S.C. 103(a) as being unpatentable over Kitna in view of Becker.

Claims 21, 22 and 35-37 have been amended to overcome this rejection.

In particular, claims 21 and 36, have been amended so as to state the following step:

(e) moving a transport device along a rack aisle to a position adjacent to said stationary vertical conveyor and above said loading track;

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This step has been added to the claims and the applicant believes that with the addition of this step, the process claimed in claims 21 and 36 is patentable over the above cited references taken either singly or in combination.

In addition, the amendments to claims 35 and 37 are also significant because these amendments include the following two amended passages:

a plurality of rack aisles disposed between said plurality of rack bays and extending out above said loading track;

a plurality of stationary vertical conveyors ... positioned above said loading track; and

These amendments are supported in FIG. 2 and in the specification on page 14 lines 11-13.

Because neither Kitna nor Becker show a system wherein a transport device can move out in aisles above a loading track to load into a vertical conveyor, the applicant believes that the remaining claims are patentable over the above cited references.

The Examiner relies on the design of Becker to combine Becker with the design of Kitna. In particular, the Examiner states that it would be obvious to combine the design of Becker having

multiple aisles and columns with the design of Kitna.

The applicant believes that with the present amendment to claims 21, 35 36 and 37, these claims would not be obvious in view of Kitna and Becker.

First, for an Examiner to make an obvious type rejection, three criteria must be met 1) there must be some suggestion or motivation to combine the references; 2) there must be a reasonable expectation of success; 3) the prior art references must teach or suggest all of the claim limitations. See MPEP 2143.

The Federal Circuit has also outlined this principle by stating that before the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so... In Re Jones, 958 F.2d 347, 21 U.S.P.Q. 2d 1941 (Fed Cir. 1992), See Also In Re Fine, 837 F.2d 1596, 1598-99 (Fed Cir. 1988).

The applicant believes that there is no suggestion in this case for any type of combination. Kitna does not suggest using

multiple columns or aisles, and the design of Kitna would not suggest this combination either. This is because both types of the vertical lifter(s) in Kitna are not designed for a system having a plurality of aisles or a plurality of columns for storing boxes. A solid vertical lifter would not allow a loading track to pass below and a paternoster type device shown in FIG. 17 of that reference is completely unlike the vertical lifter of Becker. Therefore, the applicant believes that independent claims 21, 35, 36, and 37 as amended are patentable over the above references.

Kitna for example, shows two different embodiments. The first embodiment in Kitna shows the following features which differ from the design of the present invention in claims 35 and 37 and ultimately function differently than the process in claims 21 and 36:

a) a single solid vertical conveyor which can be used to load cartons or other objects on either side;

b) two loading tracks disposed on either side of the single vertical conveyor;

c) a set of rails down a single column extending to the vertical conveyor but not over the loading track.

The function of this embodiment is entirely different because with a solid conveyor it would be impossible to perform the following step of claims 21 and 36:

*transporting the load via a transport device in a first horizontal direction along a loading track that extends along front ends of the plurality of rack bays to a stationary vertical conveyor at a front end of a target rack bay;*

It would be impossible to perform this type of operation since Kitna has a solid vertical conveyor and if it extended down into the loading track the loading track could not extend along the "front ends" of the plurality of rack bays. In this case, only one of the rack bays would be possible.

Alternatively, the design of the other embodiment, that of the embodiment shown in FIG. 17, includes a paternoster design which has a plurality of lifting brackets extending in an endless loop. In addition, this design includes a conveyor system with a plurality of rollers wherein the rollers allow a package to move

along the conveyor to this single lift. Because there are rollers and not rails, a transport device could not move the object to be loaded into the vertical transport device. Thus, the applicant believes that independent claims 21, 35, 36, and 37 are patentable over the above cited references to Kitna and Becker.

This view is reinforced by the Federal Circuit's view that "Mere fact that prior art may be modified to reflect features of claimed invention does not make modification, and hence claimed invention, obvious unless desirability of such modification is suggested by prior art..." In Re. Kitch, 922 F.2d 1260, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992).

Regarding the second requirement, the applicant believes that there can not be any reasonable expectation of success at arriving at the design of the present invention because the design of the present invention would be impossible if a party combined the designs of Kitna and Becker. For example, the design of Becker could not work using the vertical lift of Kitna because Kitna discloses either a solid vertical lift or a paternoster which would ultimately fail when combining with the multiple aisles or the loading track of Becker. Instead, a significant amount of

additional engineering and design work would be required to arrive at the process disclosed in claims 21 and 36 and the designs of claims 35 and 37. The effective design of the present invention including rack aisles extending over the loading track could not be expected from the design of the above references. Therefore, the applicant believes that independent claims 21, and 35-37 are patentable over the above cited references taken either singly or in combination.

The third requirement requires that both of the references must teach or suggest all of the claim limitations. The applicant believes that in claims 21 and 36, the following limitation is not shown or suggested by the art:

(e) moving a transport device along a rack aisle to a position adjacent to said stationary vertical conveyor and above said loading track;

In particular, this step in claims 21 and 36 would be impossible in Kitna because Kitna does not have rack aisles that extend above a loading track. In addition, Becker does not show any rack aisles that extend along or above a loading track.

Regarding claims 35 and 37, the applicant believes that the following two elements are not shown or suggested by the above mentioned art:

a plurality of rack aisles disposed between said plurality of rack bays and extending out above said loading track;

a plurality of stationary vertical conveyors positioned above said loading track;

As discussed above, Kitna does not have vertical conveyors or lifts that could be positioned above a loading track while Becker does not disclose or even suggest aisles extending out over a loading track. While Becker does show multiple aisles, none of the FIGS. in Becker show rack aisles that extend above a loading track as claimed in claims 35 and 37. Therefore, the applicant believes that claims 35 and 37 as well as dependent claims 25-29, 31, 33 and 34 which depend from claim 35 are also allowable. Furthermore, the applicant believes that independent claims 21 and 36 along with dependent claims 22 and 23 which depend from claim 21 are also patentable over the above cited art.

In summary, claims 21, 22, and 35-37 have been amended. claims 1-20, 24 30, and 32 have been cancelled. No new matter has

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been added. In view of the foregoing, it is respectfully requested that the claims be allowed and that this case be passed to issue.

Applicant respectfully request that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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I hereby certify that this correspondence is being sent by facsimile transmission to the U.S.P.T.O. to Patent Examiner FOX at Group No., to 1-703-872-9327 on June 24, 2004.

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